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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,184	05/09/2001	Glenn Petkovsek	USA-P-00-001	4886

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/852,184

Applicant(s)

PETKOVSEK, GLENN

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Response to Arguments***

1. In view of the Appeal Brief filed on October 6, 2003, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

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(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-7' are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 discloses "a first layer....wherein a first part receives a first type of electronically-imaged postage accessed over a global computer network and further wherein a second part receives a second type of electronically-imaged postage accessed over a global computer network wherein the first type of electronically-imaged postage is different from the

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second type of electronically-imaged postage...”, wherein the form has a combination of a first type postage and a second type postage. This is completely different from what the specification is disclosing (on page 6, lines 5-10), in which “The first stamp subsection (14) or the second stamp subsection (16) may contain, for example, electronically imaged postage which may be imaged by a printer or the like and on page 8, lines 19-23, in which “After postage is printed on the first stamp subsection (14) or the second stamp subsection 16 and other mailing information has been printed onto the respective subsection for the mailing information, the mailpiece may be prepared for delivery.”, wherein the specification is disclosing one type of postage or another.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. In Claim 1, it is not understood how “the first type of electronically-imaged postage is different from the second type of electronically-imaged postage”. What distinguishes one from the other? The differences are not disclosed in the specification.

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### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,089,613 (Petkovsek) in view of PAP US 2002/0103697 (Lockhart et al).

Petkovsek disclose in Claims 1 and 4, a form having: a first layer made up of a plurality of parts with a front side and a backside, wherein the front side receives indicia, and the backside

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comprises removable adhesive; and a second layer having a front side with a non-adhesive layer; wherein one of the plurality of parts receives special service mail information, sender information, and recipient information; a post card section.

However, Petkovsek does not disclose; wherein a first part of the plurality of parts receives an electronically imaged postage accessed over a global computer network necessary to effect delivery of the mailpiece; and a second part receives a second type of electronically imaged postage accessed over a global computer network necessary to effect delivery of the mailpiece.

Lockhart discloses in Fig. 8, a form comprising a electronically imaged postage accessed over a global network.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petkovsek's form to include electronically imaged indicia as taught by Lockhart et al for the purpose of allowing a user to cost-effectively create and distribute individualized surface mailings using an easy to use computer interface available over the Internet.

In regards to **Claim 1**, the limitation "wherein the electronically image information is necessary to effect the delivery of the mailpiece" does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only structure implied by the steps. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed Cir. 1985).

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Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any type of indicia on the first and second part in any specific arrangement or content (first part indicia is different from second part), since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person



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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 2, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Crandall et al (5,782,494).

Crandall et al discloses a form comprising: a first layer (21) having a front side (26) and a back side (22) wherein the front side has a plurality of parts (various sections divided by die-cut) which receive indicia; a second layer (25) having a front side (A) with a non-adhesive layer (Col. 5, lines 4-17), wherein the plurality of parts are removably secured (by adhesive 27).

However, Crandall et al does not disclose: wherein the plurality of parts receive electronically imaged postage accessed over a global network wherein the electronically image information is necessary to effect the delivery of the mailpiece.

In regards to **Claims 1**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable indicia on the form such as sender, recipient information ...etc, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. Furthermore, the electronically imaged information being accessed over a global computer network wherein the electronically imaged information is

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necessary to effect the delivery of the mailpiece does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps (see MPEP 2113). As claimed, Crandall et al discloses the structure of the form as set forth above.

6. Claims 3-7, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Crandall in view of Petkovsek (6,241,844).

Crandall et al discloses a form comprising all the elements as claimed in Claim 1, and as set forth above. However, Crandall et al does not disclose: wherein one of the plurality of parts receives: special service information, sender information and recipient information; a postcard section; and a special mailing service section.

Petkovsek discloses in Fig. 1, a form comprising a plurality of parts which can receive special service information, sender information, and recipient information (Col. 5, lines 1-16).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Crandall et al's form to include mailing information as taught by Petkovsek for the purpose of tracking an article upon which the form parts are applied.

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*Response to Arguments*

7. Applicant's arguments filed on December 16, 2002 have been fully considered but they are not persuasive.

In regards to applicant's arguments that the electronically image information is necessary to effect the delivery of the mailpiece, the examiner submits that the indicia placed on the substrate is not functionally related to the substrate. The substrate (form with adhesive backing) is merely support for the indicia applied to the surface of the substrate. Thus, there is no meaningful functional relationship between the indicia and the substrate. Furthermore, applicant's claim disclosure of a form containing both a "first type" of postage and a "second type" of postage is not supported by the specification. The specification discloses that the form may contain one type or the other, but not both.

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### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

December 23, 2003



Daniel W. Howell  
Primary Examiner  
Art Unit 3722  
*reopening after brief*